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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/734,655

12/11/2003

Christian Peter Behrenbruch

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05/03/2006

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EXAMINER

AGWUMEZIE, CHARLES C

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/734,655	<b>Applicant(s)</b> BEHRENBRUCH ET AL.	
	<b>Examiner</b> Charlie C. Agwumezie	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                        |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>03/30/04</u> . | 6) <input type="checkbox"/> Other: _____   |

## DETAILED ACTION

### Status of Claims

1. Claims 1, 5, 6, 7, 9, 16 and 20, are amended. Claims 1-20 are pending in this application per the response to office action filed February 03, 2006.

### *Response to Arguments*

2. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 5, 6, 7, 9, 16 and 20, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification as originally filed contains no support for "biological subject". There are new claims without support in the specification. This is the first instance of this invention that is unrelated and unsupported by the original filing. Cancellation of the new matter is required.

Applicant's amendments/arguments filed February 03, 2006 have been considered but are deemed without merit since the applicant argues an invention lacking support in the specification and based entirely on new matter.

4. **Claim 1-20**, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-20, are simply vague and ambiguous and fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1-11, 16, and 18-20**, are rejected under 35 U.S.C. 102(e) as being anticipated by Heckman U.S. Patent Application Publication No. 2002/0164063 A1.

6. As per **claim 1**, Heckman discloses a processing system comprising an processing apparatus and a processing agent, the processing agent being

Art Unit: 3621

administrable to a processing subject and having in relation thereto a primary behaviour effective in combination with said processing apparatus to achieve a desired process result, wherein the processing agent further has a distinctive signature characteristic distinguishing it from other processing agents, and wherein the processing system comprises test functionality to test for the distinctive signature characteristic of the processing agent and selectively to modify subsequent operation of the processing apparatus based on the test result (0007; 0008; 0050; 0057, 0060-0066; 0117; 0118; 0127; 0128).

7. As per **claim 2**, Heckman further discloses a processing system, wherein the test functionality is effective to disable, at least partially, subsequent operation of the processing apparatus in the absence of said distinctive signature characteristic (0011; 0050).

8. As per **claim 3**, Heckman further discloses a processing system wherein the test functionality is effective to disable, at least partially, output of the process result in the absence of said distinctive signature characteristic (0011; 0050; 0124).

9. As per **claim 4**, Heckman further discloses a processing system, wherein the processing agent comprises a first component for providing said primary behavior and a second component having said distinctive signature characteristic (0048; 0057; 0115; 0117; 0118).

10. As per **claim 5**, Heckman further discloses a processing system, wherein the distinctive signature characteristic is in the behavior of the processing agent in the processing subject (0115; 0117; 0118).

11. As per **claim 6**, Heckman further discloses a processing system, wherein the distinctive signature characteristic is in the time-dependent behaviour of the processing agent in the processing subject (0122; 0124; 0128).

12. As per **claim 7**, Heckman further discloses a processing system wherein the distinctive signature characteristic is in the spatially-dependent behaviour of the processing agent in the processing subject (0115; 0117; 0118).

13. As per **claim 8**, Heckman further discloses a processing system, wherein the distinctive signature characteristic is a property of the processing agent detectable by the processing apparatus (0115; 0117; 0118).

14. As per **claim 9**, Heckman further discloses a processing system, wherein the processing apparatus comprises an analysis apparatus, the processing agent comprises an analysis agent and the processing subject is an analysis subject, the analysis agent being administrable to the analysis subject and having in relation thereto a primary behavior effective to reveal upon analysis by the analysis apparatus a

Art Unit: 3621

condition of the analysis subject as said process result (0057, 0060-0066; 0117; 0118; 0127; 0128).

15. As per **claim 10**, Heckman further discloses an analysis system, wherein the distinctive signature characteristic is a property of the processing agent detectable by the analysis apparatus on analysis of the primary behaviour of the analysis agent (0117; 0118; 0119; 0138).

16. As per **claim 11**, Heckman further discloses an analysis system wherein the analysis apparatus is a medical imaging apparatus and the analysis agent comprises a contrast agent (0008; 0067; see claim 3).

17. As per **claim 16**, Heckman further discloses a processing system wherein the processing subject is a human being, plant or animal (0154).

18. As per **claim 18**, Heckman further discloses a computer program comprising program code means for providing on a programmed data processor test functionality for use in a processing system (0163; 0169; see claim 23).

19. As per **claim 19**, Heckman further discloses a computer program further comprising program code means for controlling said processing apparatus to achieve said desired process result (0051; 0163; 0169; 0117; see claim 23).

20. As per **claim 20**, Heckman further discloses a processing agent for use in a processing system and having in relation to a predetermined processing subject a primary behaviour effective in combination with said processing apparatus to achieve a desired process result, and further having a distinctive signature characteristic distinguishing it from other processing agents and distinguishable by said test functionality (0050; 0057, 0060-0066; 0117; 0118; 0127; 0128).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. **Claims 14, and 15**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Heckman U.S. Patent Application Publication No. 2002/0164063 A1 in view of Ochs et al U.S. Patent Application Publication 2004/0111220.

22. As per **claim 14**, Heckman et al failed to explicitly disclose an analysis system wherein the distinctive signature characteristic is the magnetic resonance spectrum of the contrast agent.

Ochs et al discloses an analysis system wherein the distinctive signature characteristic is the magnetic resonance spectrum of the contrast agent (0172).



Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Heckman and incorporate the system wherein the distinctive signature characteristic is the magnetic resonance spectrum of the contrast agent as taught by Ochs et al et al in order to archive economic advantage by expanding use for the system.

23. As per **claim 15**, Heckman further discloses an analysis system wherein the analysis agent comprises the contrast agent but further failed to explicitly disclose component having a distinctive magnetic resonance spectrum to provide said distinctive signature characteristic.

Ochs et al discloses an analysis system wherein the analysis agent comprises the contrast agent and a further component having a distinctive magnetic resonance spectrum to provide said distinctive signature characteristic (0172; claim 7).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Heckman and incorporate the system wherein the analysis agent comprises the contrast agent and a further component having a distinctive magnetic resonance spectrum to provide said distinctive signature characteristic as taught by Ochs et al et al in order to archive economic advantage by expanding use for the system.

24. **Claims 12 and 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Heckman U.S. Patent Application Publication No. 2002/0164063 A1 in view of

Art Unit: 3621

Ochs et al U.S. Patent Application Publication 2004/0111220 as applied to claim 11 above, and further in view of Drukier et al U.S. Patent 6,225,132.

25. As per claim 12, both Heckman and Ochs et al failed to explicitly disclose an analysis system wherein the analysis agent comprises two radio isotopes of different decay characteristics to provide said distinctive signature characteristic.

Drukier et al discloses an analysis system wherein the analysis agent comprises two radio isotopes of different decay characteristics to provide said distinctive signature characteristic (col. 12, lines 54-67; col. 13, lines 55-67; col. 14, lines 1-14).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Heckman and incorporate the system wherein the analysis agent comprises two radio isotopes of different decay characteristics to provide said distinctive signature characteristic as taught by Drukier et al in order to show expanded use of such system.

26. As per claim 13, Heckman and Ochs et al failed to explicitly disclose an analysis system wherein the analysis agent comprises a component emitting photons of a particular energy to provide said distinctive signature characteristic.

Drukier et al discloses an analysis system wherein the analysis agent comprises a component emitting photons of a particular energy to provide said distinctive signature characteristic (col. 12, lines 54-67; col. 13, lines 55-67; col. 14, lines 1-14).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Heckman and incorporate the system wherein the analysis agent comprises a component emitting photons of a particular energy to provide said distinctive signature characteristic as taught by Drukier et al in order to archive economic advantage by expanding use for the system.

27. **Claims 17**, is rejected under 35 U.S.C. 103(a) as being unpatentable over Heckman et al U.S. Patent Application Publication No. 2002/0164063 A1 in view of Wong et al U.S. Patent 6,264,948.

28. As per **claim 17**, Heckman failed to explicitly disclose a processing system wherein the processing subject is in vitro.

Wong et al discloses a processing system wherein the processing subject is in vitro (col. 11, lines 40-56).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Heckman and incorporate the system wherein the processing subject is in vitro as taught by Wong et al in order to archive economic advantage by expanding use for the system.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of

Art Unit: 3621

the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charlie C. L. Agwumezie whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on **(571) 272 – 6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Any response to this action should be mailed to:

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**Washington D.C. 20231**

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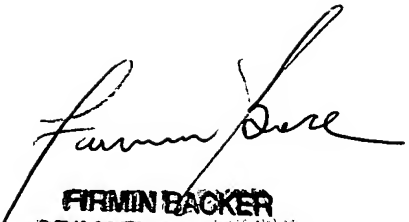
Alexandria VA. 22314

Charlie Lion Agwumezie

Patent Examiner

Art Unit 3621

April 21, 2006



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